

REMARKS/ARGUMENTS

Claim Status

Claims 1 and 4-20 are pending. The pending claims are rejected as follows: (i) claims 1, 4, 5 and 8-19 are rejected as anticipated by *Haeberle et al.* (US 5,387,367); (ii) claims 1, 4-6 and 8-19 are rejected as obvious in view of *Haeberle et al.* and *Morikawa et al.* (US 5,652,300); and (iii) claims 7 and 20 are rejected as obvious in view of *Haeberle et al.*, alone or in combination with *Morikawa et al.*, and *Weyland et al.* (US 5,587,421). Applicants respectfully traverse these rejections.

Response to Outstanding Rejections

A. The Office has based its anticipation rejection over *Haeberle* on the following premises: (i) that *Haeberle* anticipates the claimed mixture because, even though *Haeberle* does not expressly disclose mixtures having the claimed amounts of the components of the claimed mixture, "one would have immediately envisioned polyisocyanate component amounts of the blend, such as 50:50 mixtures" which could fall within the claimed amounts (Office Action: page 4, lines 1-6), and (ii) that *Haeberle* anticipates the claimed mixture because, even though *Haeberle* does not expressly disclose mixtures having the claimed amount of the components of the claimed mixture, *Haeberle* inherently discloses mixtures that fall within the claimed weight % limitations of Applicants mixture components (Office Action: page 4, lines 6-14).

As explained in Applicants previous response with respect to (i), "immediately envision" is not the standard of proof with respect to anticipation of claimed limitations (see again M.P.E.P. 2131 which states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). With respect to (ii), as also previously explained by Applicants, the Office has

not met its burden of proof with respect to inherency (see again M.P.E.P. 2112 (Part IV)

which states: “The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ... To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.’”).

Therefore, if “immediately envision” or “inherency” is indeed the position(s) the Examiner is taking, Applicants respectfully request the withdrawal of the anticipation rejection based on (i) the use of an improper standard with respect to a rejection based on anticipation, and (ii) failing to meet the burden with respect to an inherency based anticipation rejection.

B. Additionally, the Office asserts that even if *Haeberle* were considered insufficient by itself to anticipate the weight % limitations of the claimed mixture's components, the incorporation of *Morikawa* (wt% ratio range) fulfills this deficiency and renders obvious the claimed invention. Applicants respectfully disagree.

Applicants point out that the Office has apparently ignored Applicants' previous showing of unexpected results of pendulum damping/hardness of the claimed invention (see last paragraph of page 8 through page 9 of response filed on April 15, 2008). The data tables as well as the direct comparison between Examples 1-4 and Comparative Example C of the 4/15/08 response is believed to show the criticality of claimed weight % limitations of the components of the claimed mixture.

This previous showing of criticality is an acceptable form of rebuttal to an alleged case of *prima facie* obviousness as explained in MPEP 2144.05 Part III which states:

“Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range. ‘The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims.’ ...”.

Furthermore, it should be noted that the Office has inappropriately dismissed Applicants showing of criticality with the unsubstantiated assertion that “applicants’ results are not unexpected, since Morikawa et al. disclose ... at column 5, lines 30-42 the relationship between hardness and the IPDI-based component” (Office Action dated June 13, 2008, page 7). While it may be true that *Morikawa* discloses a relationship between hardness and the IPDI-based component, such a “relationship” is merely recited as “use of a NCO-terminated modified non-yellowing IPDI (b) makes it possible to achieve a *high* hardness” and “[w]hen the amount of the NCO-terminated modified IPDI (b) mixed is smaller than the above range, it is impossible to obtain a *high* hardness” (col. 5, lines 30-35 - italics emphasis added). Therefore, unless the Examiner is alleging specific knowledge of what “*high* hardness” actually corresponds to in a numerical value, it is not understood how Applicants evidence (numerical values) of superior pendulum damping/hardness is “not unexpected” as asserted by the Office.

Moreover, the Office has not only failed to corroborate the base-less position of “expectedness” but has also failed to provide any additional arguments or *counter-evidence* in opposition to Applicants showing that the claimed ranges are critical. Accordingly, as Applicants have rebutted the *prima facie* case of obviousness with a showing of criticality pursuant to MPEP 2144.05 Part III, and the Examiner has failed to properly counter the rebuttal, Applicants respectfully request withdrawal of the obviousness rejections.

C. Lastly, as even *further* evidence of unexpectedness in rebuttal to the allegations of obviousness, Applicants newly submit that the claimed invention provides for an added unexpected result in addition to the superior pendulum damping/hardness. Namely, the claimed mixtures/dispersions have enhanced emulsifiability resulting in a superior shelf-life (specification: page 3, lines 17-21). Applicants have informed the undersigned that the claimed mixtures/dispersions exhibit extended shelf-lives of up to 50% longer than those of the art.

Again, Applicants point out MPEP 2145 which states:

“Rebuttal evidence may also include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art. Rebuttal evidence may consist of a showing that the claimed compound possesses unexpected properties.”

Accordingly, Applicants have again provided rebuttal evidence against the Office’s allegations of obviousness. It should be noted that this newly presented unexpected result (i.e., extended shelf-life) is *in addition to* the already provided evidence of unexpected pendulum damping/hardness which in and of itself is enough evidence to rebut the allegations but is merely being supported by further evidence of additional unexpected results.

Therefore, as both *Haeberle* and *Morikawa* are silent with respect to shelf-life, these references, alone or in combination, cannot be said to either disclose or suggest that which they fall silent on. Accordingly, as this result is yet again another unexpected result of the claimed invention, this result (i.e., superior shelf-life) in combination with the other results (i.e., superior pendulum damping/hardness) rebuts the obviousness allegations made by the Office. Thus, Applicants respectfully request withdrawal of the obviousness rejections.

Conclusion

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.

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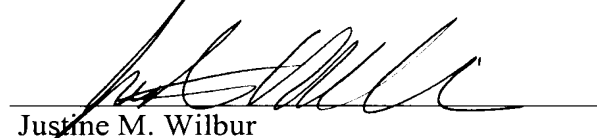
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(OSMMN 08/07)

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Justine M. Wilbur', is written over a horizontal line.

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